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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HUNTER, ALVIN A

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/25/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,708

Applicant(s)

NESBITT ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7-11,13-17,19-25,28-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,15,23,31 and 32 is/are allowed.
- 6) ☒ Claim(s) 5,7-9,11,25,33 and 35 is/are rejected.
- 7) ☒ Claim(s) 10,13,14,16,17,19-22,28-30,36 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

The indicated allowability of claims 8, 12, 18, 26, and 34 are withdrawn in view of the newly discovered reference(s) to Yamagishi et al. (USPN 5688595). Rejections based on the newly cited reference(s) follow.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5, 7-9, 11, 33, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamagishi et al. (USPN 5688595).

Yamagishi et al. discloses a golf ball having a core, comprising a structure of at least two layers, and a cover, comprising an inner and outer cover layer, surrounding the core (See Abstract). The core comprises an inner sphere and a surrounding layer wherein the surrounding layer may be a single layer or have a plurality of layers (See Column 3, lines 21 through 29). The inner sphere is made of polybutadiene, a diene containing rubber, and has a diameter of 20 to 39mm, or 0.79 to 1.54 inches (See Column 4, lines 5 through 20 and paragraph bridging Columns 4 and 5). The surrounding layer(s) is made of ionomer resin or a rubber base material like the inner sphere and give the entire core a diameter of 35 to 41mm, 1.38 to 1.61 inches (See

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Column 4, lines 33 through 41). The inner and outer cover layers are made of ionomer resins and non-ionomer resins alone or in admixture (See Column 4, lines 1 through 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al. (USPN 5688595) in view of Wu (USPN 5334673).

Yamagishi et al. discloses a golf ball having a core, comprising a structure of at least two layers, and a cover, comprising an inner and outer cover layer, surrounding the core (See Abstract). The core comprises an inner sphere and a surrounding layer wherein the surrounding layer may be a single layer or have a plurality of layers (See Column 3, lines 21 through 29). The inner sphere is made of polybutadiene, a diene containing rubber, and has a diameter of 20 to 39mm, or 0.79 to 1.54 inches (See Column 4, lines 5 through 20 and paragraph bridging Columns 4 and 5). The surrounding layer(s) is made of ionomer resin or a rubber base material like the inner sphere and give the entire core a diameter of 35 to 41mm, 1.38 to 1.61 inches (See Column 4, lines 33 through 41). The inner and outer cover layers are made of ionomer resins and non-ionomer resins alone or in admixture (See Column 4, lines 1 through 4). Yamagishi et al. does not explicitly disclose the cover layer comprising polyurethane. Wu discloses a golf ball cover made of polyurethane. The polyurethane is preferable

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over ionomer resin because it employs the cut resistance and low cost of that of ionomer resins but also provides the click and feel of that of a balata cover which the ionomer resin cannot provide. One having ordinary skill in the art would have found it obvious to create a cover using polyurethane instead of ionomer resin because it provide an additional click and feel characteristics which the ionomer resin cannot provide.

### ***Allowable Subject Matter***

Claims 1, 3, 15, 23, 31, 32 are allowed.

Claims 10, 13, 14, 16, 17, 19-22, 28-30, 36, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, 5, and 7-37 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read 'P. Sewell', is positioned above the printed name.

Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700